

**REMARKS**

Applicants thank the Examiner for the careful consideration of this application. Claims 1-24 are currently pending. Claims 1 and 4 have been amended. Claims 12-24 have been withdrawn. Based on the foregoing amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

**Restriction Requirement**

The Office Action states in paragraph 3 that the Applicants must confirm their election of the invention of Group I, claims 1-11, drawn to a method of making ice cream. The Applicants hereby confirm the election of the invention of Group I, claims 1-11. Claims 12-24, drawn to the invention of Group II, have been withdrawn from consideration.

**Rejections under 35 U.S.C. § 102**

The Office Action rejects claims 1-3 and 5-11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,510,890 to Paskach et al. ("Paskach"). Claim 1 is the independent claim. The Applicants traverse this rejection for at least three reasons.

*First*, Paskach does not disclose a method of making an ice cream product comprising "mechanically mixing the ingredients with a liquefied gas," as recited by amended claim 1. In contrast, Paskach states that the "premix and refrigerant combine naturally, i.e., *without the assistance of mechanical mixing means*, inside the mixer 166." (See Paskach at 4:42-45 (emphasis added).) In fact, Paskach expressly teaches away from the step of "mechanically mixing the ingredients with a liquefied gas". For example, Paskach states in the Summary

section that “[a]n apparatus for making a frozen food product comprising a mixer *having no moving parts* is disclosed.” (See Paskach at 1:53-54 (emphasis added).) Therefore, Paskach does not anticipate claim 1. Claims 2, 3, and 5-11 depend variously from claim 1, and are patentable for at least the same reasons.

*Second*, contrary to the Office Action’s assertion in paragraph 11, Paskach does not inherently disclose “mixing in sufficient liquefied gas to surround at least most of the container,” as recited by dependent claim 8. To establish a case of inherent anticipation, the claim element must have existed or occurred in the reference to a certainty (*i.e.*, not just a possibility or probability). See *Scaltech, Inc. v. Retec/Tetra, LLC*, 178 F.3d 1378, 1384 (Fed. Cir. 1999). There is nothing in Paskach that indicates to a *certainty* that sufficient refrigerant gas is mixed with the premix to “surround at least most of the container.” Rather, Paskach is completely silent about the amount of excess refrigerant gas supplied. (See Paskach at 4:45-48.) It is quite possible based on the disclosure of Paskach that the amount of excess gas supplied, if any, is only sufficient to surround a very small portion of the mixer 116. Therefore, Paskach does not inherently disclose “mixing in sufficient liquefied gas to surround at least most of the container,” as recited by dependent claim 8. Accordingly, Paskach does not anticipate claim 8 for this additional reason.

*Third*, Paskach does not inherently anticipate dependent claims 10 and 11. Claim 10 recites, in part, that the vapor is visible to a customer. Claim 11 recites, in part, that the vapor can be touched by a customer. The Office Action states in paragraph 12 that these features would be inherent based on the disclosure in Paskach that the customer can be involved in the

customization of the product by the addition of toppings, apparently relying on column 5, lines 55-61 of Paskach. However, the mere involvement of the customer in the addition of toppings to the ice cream does not demonstrate, *to a certainty*, that the excess vapor referenced in column 4, lines 45-48 of Paskach is visible to the customer, or that it can be touched by the customer. Rather, it is quite possible based on the disclosure of Paskach that the excess vapor is located somewhere in the system 100 that is concealed from the customer's sight and touch. Therefore, Paskach does not inherently anticipate claims 10 and 11. *See Scaltech*, 178 F.3d 1378, 1384.

For the reasons discussed above, the Applicants submit that claims 1-3, and 5-11 are patentable over Paskach. Accordingly, the Applicants respectfully request withdrawal of this rejection.

#### Rejections under 35 U.S.C. § 103

The Office Action rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Paskach. The Applicants respectfully traverse this rejection. Claim 4 depends from claim 1, which recites "mechanically mixing the ingredients with a liquefied gas." As demonstrated above, Paskach does not disclose this claim feature. Instead, Paskach expressly *teaches away* from this claim feature. (*See, e.g.*, Paskach at 1:53-54.) Therefore, claims 1 and 4 are both patentable over Paskach. Accordingly, the Applicants respectfully request withdrawal of this rejection.

#### Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants, therefore, respectfully request that the Examiner reconsider all

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presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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